

REMARKS

I. Introduction

With the addition of new claims 19 to 22, claims 1 to 22 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note that the Office Action Summary does not include an acknowledgement of the claim for foreign priority or an acknowledgement of receipt of the certified copy of the priority document. A claim of priority to German Application No. 103 09 679.5 was made, e.g., in the "Declaration and Power of Attorney" filed on February 27, 2004, and a certified copy of German Application No. 103 09 679.5 was filed on February 27, 2004. Thus, an acknowledgement in the next Office communication of the claim for foreign priority and receipt of the certified copy of the priority document is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Rejection of Claims 1 to 18 Under 35 U.S.C. § 103(a)

Claims 1 to 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,175,109 ("Setbacken et al.") and U.S. Patent No. 4,363,964 ("Schmitt"). It is respectfully submitted that the combination of Setbacken et al. and Schmitt does not render unpatentable the present claims for at least the following reasons.

Claim 1 relates to a scanning unit for scanning a measuring standard including a coded track formed by a graduated scale and a reference mark system. Claim 1 recites that the scanning unit includes: a detector system configured to scan the coded track; an additional detector system, including at least two sensors, configured to scan the reference mark system; and a differential amplifier including two inputs. Claim 1 has been amended herein without prejudice to recite that each of the at least two sensors of the additional detector system is positioned to scan the reference mark system. Support for this amendment may be found, for example, at page 9, lines 1 to 8 of the Specification. Claim 1 further recites that the additional detector system is configured to use only one of the at least two sensors to scan the reference mark system during operation of the scanning unit and that the scanning

unit includes an arrangement configured to cover a signal-sensitive surface of a sensor of the at least two sensors of the additional detector system not used for scanning to deactivate the sensor not used for scanning. According to claim 1, each of the sensors is connected to a respective one of the two inputs of the differential amplifier.

Independent claim 18 has been amended herein without prejudice in analogous manner as claim 1.

The Office Action admits that Setbacken et al. fails to disclose: (1) use of only one of at least two sensors to scan a reference mark system; (2) a differential amplifier including two inputs, and (3) an arrangement configured to cover a signal-sensitive surface of a sensor not used for scanning. The Office Action refers to Schmitt for allegedly disclosing these features. However, the occluding screen 21 described by Schmitt, which the Office Action contends constitutes an arrangement configured to cover, does not cover a sensor that is positioned to scan a reference mark system. Rather, the occluding screen 21 controls the illumination or non-illumination of photosensitive element 16 (col. 4, lines 31 to 35), which, according to Schmitt, generates a cancelling signal that tends to cancel a signal generating by photosensitive element 12 (col. 3, lines 50 to 52). The photosensitive element 16 is not positioned to scan the fixed reference mark 4. The only device described by Schmitt that is positioned to scan the fixed reference mark 4 is the photoelement element 12. Thus, Schmitt fails to disclose an additional detector system configured to scan a reference mark system, in which the additional detector system includes at least two sensors, each of which is positioned to scan a reference mark system. Consequently, Schmitt also fails to disclose: an additional detector system configured to use only one of at least two sensors, which are positioned to scan a reference mark system, to scan the reference mark system during operation of a scanning unit; a differential amplifier including two inputs, each of at least two sensors, which are positioned to scan a reference mark system, connected to a respective one of the two inputs; and an arrangement configured to cover the signal-sensitive surface of a sensor of at least two sensors, which are positioned to scan a reference mark system, not used for scanning to deactivate the sensor not used for scanning.

Thus, the combination of Setbacken et al. and Schmitt fails to disclose all of the features included in claims 1 and 18.

Furthermore, the Office Action fails to set forth a prima facie case of obviousness consistent with the Supreme Court's KSR decision and consistent with the provisions set forth in M.P.E.P. § 2142 et seq. A rejection under 35 U.S.C. § 103(a) cannot be sustained with mere conclusory statements; rather, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. KSR International Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385, 1386 (2007). Among the rationales that may support a conclusion of obviousness are: (a) combining prior art elements according to known methods to yield predictable results; (b) simple substitution of one known element for another to obtain predictable results; (c) use of known technique to improve similar devices (methods, or products) in the same way; (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (e) "obvious to try" -- choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. The Office Action does not even allege any of the foregoing rationales and fails to sufficiently articulate any findings necessary to support the present rejection.

In view of the foregoing, it is respectfully submitted that the combination of Setbacken et al. and Schmitt fails to render unpatentable claims 1 and 18.

As for claims 2 to 17, which ultimately depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that the combination Setbacken et al. and Schmitt does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. New Claims 19 to 22

New claims 19 to 22 have been added. It is respectfully submitted that claims 19 to 22 add no new matter and are fully supported by the present application, including the Specification.

Since claims 19 and 20 depend from claim 1, it is respectfully submitted that claims 19 and 20 are patentable over the references relied upon for at least the reasons more fully set forth above in support of the patentability of claim 1.

Since claims 21 and 22 depend from claim 18, it is respectfully submitted that claims 21 and 22 are patentable over the references relied upon for at least the reasons more fully set forth above in support of the patentability of claim 18.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: June 26, 2008

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646